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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,106	01/11/2002	Maxime Allard	IN-5528	5758
26922	7590	03/12/2004	EXAMINER	
BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442			MCCLENDON, SANZA L	
		ART UNIT	PAPER NUMBER	
		1711		

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/018,106	ALLARD ET AL. 
Examiner	Art Unit	
Sanza L McClendon	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 January 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-4,6,7 and 9-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4,6,7 and 9-16 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/01 & 7/03.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____ .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, and 14-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-12 of copending Application No. 10/009,394. Although the conflicting claims are not identical, they are not patentably distinct from each other because components (a1), (a2) and (a3)-(a7) recited in claim 1 of the instant application can be the same (a1)-(a7) components of 10/009,394. Component (a1) of the instantly claimed invention comprises at least two functional groups that crosslink under actinic radiation with an optional thermally crosslinkable functional group, which are the same in 10/009,394, wherein both applications claim said actinic crosslinkable groups can be

Art Unit: 1711

either ethylenically unsaturated groups or epoxide groups, preferably urethane (meth) acrylate compounds—see claims 1-3, and 15 (instant application) and claims 11-12 (10/009, 934). Component (a2) comprises two radiation crosslinkable functional groups and a thermally crosslinkable functional group reactive with functional group (a12) of (a1), which are the same in both applications, wherein (a2) can be a member selected from a (meth) acrylate-functional (meth) acrylate copolymer containing free isocyanate groups, a (meth) acrylate-functional polyisocyanate—see claims 1, 3, and 14 of the instant application and claims 10 and 12 of 10/009, 934. It would have been obvious at the time of the instant invention to provide a composition comprising components (a1)-(a7) as set forth in the instant invention from the corresponding composition as set forth by 10/009, 934.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6-7, and 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 99 141 (translation provided by applicant).

DE '141 teaches thermally and actinic curable compositions useful for coating plastic substrates, in addition to SMC and BMC substrates. Said compositions comprises (a1) at least one component (a1) with (a11) at least two functional groups curable by actinic radiation and, optionally, (a12) at least one functional groups

Art Unit: 1711

curable/crosslinkable by thermal energy with a functional groups (a22) in component (a2); and ((a2) at least one component (a2) having (a21) at least two functional groups crosslinkable by actinic radiation and, optionally, (a22) at least one functional group that can enter into thermal crosslinking reactions with a functional group (a12) in component (a1); (a3) a photoinitiator; (a4) a thermal crosslinking initiator; (a5) at least one reactive diluent curable by actinic radiation and/or is thermally curable; (a6) at least one coating additive; and/or (a7) at least one thermally curable component, wherein the coating composition is comprised of at least one thermally curable component (a7) if component (a1) does not have functional group (a12). Components (a1) - (a7) of DE '141 corresponds to components (a1) - (a7) of the instant application, wherein DE '141 teaches the same trademarked materials as disclosed by the instantly claimed invention. Therefore claim 1 is anticipated. Suitable compounds for (a1) can be found on pages 10 and 12, wherein urethane methacrylate and phosphazene acrylates are taught making (a11) acrylate and/or methacrylate groups and, if present (a12) are preferably hydroxyl groups. This anticipates claims 2-3, 13, and 15 of the instant application. Suitable compounds for (a2) are found on pages 12-13, wherein it is preferable for said compound to have at least three radiation curable functional groups (a21) and at least three thermally crosslinkable groups (a22), such as isocyanate groups. This anticipates claims 3 and 14 of the instant application. (A3) and (a4) can be found on pages 13-14. Suitable compounds for (a5) are oligomeric polyol that can be found on pages 14-16, wherein said polyester polyols and oligomeric polyols are taught. Said coating additives (a6) can be found on pages 17-18. Suitable components for (a7) can be found on pages 18-24, wherein polyesters, epoxide resins and acrylate polymers are taught. In addition, it is taught that component (a7) can be thermal crosslinkers. Per example, DE '141 teaches combining a urethane acrylate with no free hydroxyl groups, a polyester polyol (Desmophen), a photoinitiator, customary coating additives, and an acrylate having free isocyanate and acrylate groups, wherein the urethane acrylate anticipates instantly claimed (a1) without functional groups (a12), the polyester

Art Unit: 1711

polyol anticipates (a7), and the acrylate having free isocyanate groups anticipates instantly claimed (a2), which in turn anticipates claim 16 of the instant application. Said coating composition can be used as a primer coating applied in one or more layers or said coating can be used as a clear coating applied in one or more layer, wherein both once applied can be cured by subjecting to a radiation step followed by a thermal curing step—see pages 25–26. This anticipates claims 4, 6, 11, wherein claims 6 and 11 are anticipated when more than one coating composition is applied to said substrates. In addition, DE '141 teaches methods of sealing SMC and BMC parts along with substrates, such as plastics, plastics employed in motor vehicle manufacture, substrate for furniture and industrial coatings, such as coils and containers—see page 6 and 25, wherein at least one of the above substrates are deemed to be microporous. Thus anticipating claims 6, 9–10 and 12. Said coating compositions once cured are free from microbubbling and blistering such that the surfaces are smooth and defect-free. This anticipates claim 6. The invention of claims 1–4 and 6–16 are deemed to be anticipated by the DE '141.

5. Claims 1–4, 6–7, and 9–16 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 199 20 799 A1.

DE '799 teaches coating and sealing microporous surfaces, such as plastics, automotive parts, fiber re-enforced plastics, SMC's and BMC's, with coating compositions curable both thermally and by radiation. Said coating compositions comprise (a1) at least one compound, such as a urethane acrylate, having (a11) at least two functional groups crosslinkable by radiation, such as acrylates and, optionally, at least one functional group that undergoes thermal crosslinking with functional groups (a22), such as hydroxyl groups; (a2) at least one compound, such as an isocyanate acrylate, having (a21) at least two functional groups, such as acrylates, for radiation crosslinking and (a22) at least one functional groups, such as isocyanates, that undergo thermal crosslinking with functional groups (a12) in (a1); (a3) at least one photoinitiator; (a4) at least one thermal crosslinking

initiator; (a5) at least one reactive diluent curable thermally and/or by radiation; (a6) at least one coating additive; and/or (a7) at least one thermally curable component, such that (a7) is present if (a1) has no functional groups (a12). Components (a1)– (a7) of DE '799 correspond to components (a1) – (a7) of the instant application, therefore claims 1-3, and 13-16 are anticipated by DE' 799. DE' 799 teaches that said coatings can be applied to a substrate and cured using both radiation and thermal energy. This anticipates claims 4, 7, 9, and 12. In addition, DE '799 teaches that said coating/sealing compositions could be used as multi-layered coating compositions that may or may not be applied in a wet-on-wet application, which once cured provide for non-blistering, non-microbubbling, smooth scratch resistant coating once cured. This anticipates claims 6 and 10-11.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1711

Sanza L McClelond

Examiner

Art Unit 1711

SMc


James J. Scinella
Supervisory Patent Examiner
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